

## **REMARKS**

At the time the Official Action was mailed, claims 1-31 were pending. Claims 1, 13, 17, 22 and 24 have been amended to set forth the claimed subject matter more clearly. Applicants respectfully request reconsideration of the claims in view of the remarks set forth below.

### **Rejections under 35 U.S.C. § 112**

The Examiner rejected claims 13, 20 and 21 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically the Examiner stated:

Claims 13 recites the limitation “wherein act (c) comprises” in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 20 and 21 recites the limitation “the applications and drivers” in line 2. There is insufficient antecedent basis for this limitation in the claim. The Examiner interprets this limitation as “the information” to be consistent with claim 17.

With regard to claim 13, Applicants have amended claim 13 to recite proper dependency on claim 12. Applicants respectfully submit that claim 13, as amended, complies with 35 U.S.C. § 112, second paragraph. Therefore, Applicants respectfully request withdrawal of the Examiner’s rejection of claim 13 under 35 U.S.C. § 112.

With regard to claims 20 and 21, Applicants have amended claim 17 on which claims 20 and 21 depend to provide proper antecedent basis for all claims dependent thereon. Applicants respectfully submit that claims 20 and 21 are fully compliant with 35 U.S.C. § 112, second paragraph. Therefore, Applicants respectfully request withdrawal of the Examiner’s rejection of claims 20 and 21 under 35 U.S.C. § 112.

### **Rejections under 35 U.S.C. § 102**

The Examiner rejected claims 1, 3, 4, 7-10, 16 and 24-31 under 35 U.S.C. § 102(e) as being anticipated by Petty (6,389,486). With regard to the independent claims, the Examiner stated:

As to claim 1 Petty teaches a method of implementing a personal digital assistant (hand-held) comprising a main unit (hosting device 16) and an option pack (PCMCIA card) (col. 3, lines 49-60) comprising the acts of: (a) coupling the option pack with the main unit (col. 3, lines 49-60), the option pack comprising a first memory device (part of memory 20) configured to store one or more applications and drivers associated with the one or more applications (set up/control/monitoring information and various other types of information), and a second memory device (part of memory 20) configured to store identification data (CIS) (col. 4, lines 17-46 and col. 2, lines 36-39), the main unit comprising a device manager (part of the hosting device which handles receiving set up/control/monitoring information from the PCMCIA card) configured to receive the identification data from the second memory device, a power supply, and a third memory device (col. 4, lines 34-46 wherein the third memory device inherently resides within the hosting device in order to store information read from the PCMCIA card); and (b) transmitting the identification data from the second memory device to the device manager (transfer of information from the PCMCIA card) (col. 2, lines 32-46).

As to claim 24, Petty teaches an option pack interface comprising: a memory device (memory 20) comprising a memory data structure configured to store identification data; and at least one data sector (I/O memory space 22, common memory 26, or attribute memory 24) defined within the memory data structure (col. 4, lines 17-46).

Applicants respectfully traverse this rejection. Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

To maintain a proper rejection under Section 102, a single reference must teach each and every element or step of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Thus, if the claims recite even one element not found in the cited reference, the reference does not anticipate the claimed invention.

The present application is directed to a personal digital assistant (PDA) having a main unit and an option pack. The option pack includes one or more applications, as well as drivers associated with the one or more applications. The software applications and software drivers are stored on the option pack to conserve memory on the main unit and to eliminate the process of downloading software from the Internet or a CDROM. Page 7, lines 11-14. Once an option pack is inserted into the main unit and the option pack is identified, the main unit determines whether it has enough battery life to power the option pack and determines whether it has enough memory space to download the applications and drivers from the option pack to the main unit. Page 26, lines 5-8; page 26, lines 14-16; page 27, lines 4-8. Once the main unit obtains the information on the drivers and applications, and determines that it has enough memory to accommodate the applications and drivers, the applications and drivers are downloaded from the option pack to the main unit. Page 27, lines 8-16.

Accordingly, claim 1 recites a method comprising “downloading the one or more applications, as well as drivers associated with the one or more applications from the option pack to the main unit.” Claim 24 recites an option pack interface having at least one data sector, “wherein the at least one data sector comprises one or more applications, as well as drivers associated with the one or more applications, and wherein the one or more applications and drivers are configured to be downloaded from the memory device to a main unit.”

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In contrast, the Petty reference discloses a method of transferring status information from a Personal Computer Memory Card International Association (PCMCIA) card to a device hosting PCMCIA cards. Col. 2, lines 27-29. The Petty reference discloses that the PCMCIA card 12 includes a memory space 20 which may comprise Static Random Access Memory (SRAM) or Dynamic Random Access Memory (DRAM). Col. 4, lines 6-20. The Examiner correlated the PCMCIA card 12 disclosed in the Petty reference with the presently recited option pack which is configured to store one or more applications and drivers. However, as can be appreciated by those skilled in the art, a PCMCIA card cannot be fairly characterized as an option pack within the scope of the presently recited claims. As can be appreciated, PCMCIA cards are generally designed to add memory to personal computers but may also be used for modem cards or portable disk drives. However, PCMCIA cards *are not* configured to store one or more applications, as well as drivers for the one or more applications, as recited in the present claims. Accordingly, it should be clear that the PCMCIA card 12 *is not* configured to store one or more applications and drivers. 15

More specifically, the Examiner cited the memory space 20 within the PCMCIA card 12 as corresponding to the presently recited first memory device configured to store applications and drivers. However, those skilled in the art would readily appreciate that the memory space 20 *is not* configured to store applications and drivers. As clearly discussed in the Petty reference, the memory space 20 within the PCMCIA card 12 comprises Random Access Memory. As can be appreciated, the information stored in the Random Access Memory 20 is lost once power is removed from the PCMCIA card 12. Accordingly, the memory space 20 cannot possibly be configured to store one or more applications and drivers as recited in the present claims since it would be pointless to have an option pack with applications and drivers that are lost whenever power is disabled. Because the Petty reference does not even disclose an

option pack having a memory device configured to store one or more applications and drivers, it cannot possibly disclose downloading the one or more applications and drivers from the option pack to a main unit, as further recited in the present claims. Accordingly, the Petty reference does not disclose every element recited in the present claimed and therefore, cannot possibly anticipate the claims subject matter.

In view of the remarks set forth above, Applicants respectfully submit that the subject matter disclosed in the Petty reference does not anticipate the subject matter of independent claims 1 and 24. Therefore, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 1, 3, 4, 7-10, 16 and 24-31.

The Examiner rejected claims 17 and 22 under 35 U.S.C. § 102(e) as being anticipated by Postman et al. (5,664,231). With regard to independent claim 17, the Examiner stated:

As to claim 17, Postman teaches a method of inserting an option pack (PC card) into a main unit of a personal digital assistant (PDA), comprising the acts of: (a) powering-on the main unit (col. 9, lines 15-24); (b) determining whether there is an option pack coupled to the main unit (automatically apply power to the input device when the PC Card is inserted) (col. 26, lines 48-48-50); (c) providing an interrupt signal from the option pack to the main unit; (d) interrupting the processing of the main unit; (e) notifying the main unit that the option pack is present (col. 26, lines 50-54 and col. 7, lines 1-5); and (f) transmitting identification information (Configuration Option/Card Configuration/Status Register) from the option pack to the main unit (col. 8, lines 43-54).

Applicants respectfully traverse this rejection. Claim 17 as amended recites "copying one or more applications, as well as drivers associated with the one or more applications, from the option pack to the main unit." As with the Petty reference, the Postman reference simply discloses a PCMCIA card (also known as a PC card). The PC card is not configured to store

one or more applications and associated drivers. Thus, the Postman reference does not disclose copying one or more applications and drivers from an option pack to a main unit, as recited in claim 17. Accordingly, the Postman reference cannot possibly anticipate the claimed subject matter. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 17 and 22.

### **Rejections under 35 U.S.C. § 103**

The Examiner rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Petty in view of Bailey et al. (6,134,612). The Examiner rejected claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Petty in view of Inoue (5,444,222). The Examiner rejected claims 11, 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Petty in view of De Nicolo (6,308,240). The Examiner rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Petty in view of De Nicolo and further in view of Miller (6,199,168). The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Petty in view of Kane et al. (5,652,832). The Examiner rejected claims 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Postman et al. in view of De Nicolo. The Examiner rejected claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Postman et al. in view of Kane. Finally, the Examiner rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Postman in view of Cepulis (6,055,596). The Examiners rejections are too lengthy to be reproduced efficiently herein. However, Applicants respectfully traverse each of the Examiner's rejections.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining or modifying the teachings of the prior

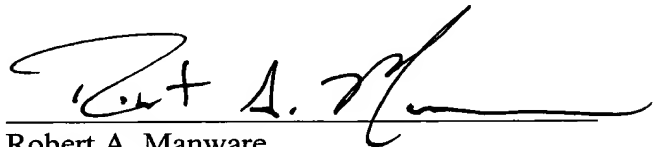
art to produce the claimed invention absent some teaching or suggestion supporting the combination or modification. *See ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination or modification to render obvious a subsequent invention, there must be some reason for the combination or modification other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination or modification. *See Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

As discussed above with regard to the rejections under 35 U.S.C. § 102, neither the Petty reference nor the Postman reference discloses all of the elements recited in independent claims 1, 17 and 24. Each of the present rejections under 35 U.S.C. § 103 cite either Petty or Postman as the primary reference for the rejections of the various dependent claims. Applicants respectfully submit that none of the cited references cure the deficiencies of the Petty and Postman references, as discussed above with respect to the independent claims. Accordingly, Applicants respectfully submit that none of the prior art references either alone or in combination discloses all of the elements recited in the present claims. Applicants respectfully request withdrawal of the Examiner's rejections under 35 U.S.C. § 103(a) and allowance of claims 2, 5, 6, 11-15, 18-21 and 23.

**Conclusion**

In view of the remarks and amendments set forth above, Applicants respectfully request withdrawal of the Examiner's rejections and allowance of claims 1-31. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert A. Manware", written over a horizontal line.

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